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EXAMINER

VU, NGOC K

ART UNIT PAPER NUMBER

2611

DATE MAILED: 11/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|-------------------------------------|--|
| Office Action Summary | Application No. 09/870,267 | Applicant(s) WHITE ET AL. | |
| | Examiner Ngoc K. Vu | Art Unit 2611 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>10/5/01, 1/9/02, 6/18/02, 8/5/02, 2/24/03</u> | Other: ____. |

DETAILED ACTION

Specification

1. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: the specification must support the feature of "restoring the state information" as recited in claim 1, line 8 and in claim 15, line 11.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 11 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 11 is misdescriptive and rendered the claim indefinite. It is misdescriptive to recite "said interactive video entertainment is overscanned". On page 10, lines 24-25 the disclosure specifically indicates that the screen is typically overscanned. It is noted that the interactive video entertainment may be the video program. With respect to the specification, the limitation in claim 11 is interpreted as "screen is overscanned" for purpose of examination. Appropriate correction is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-3, 5-7, and 12-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Dunn et al. (U.S. 5,721,829 A).

Regarding **claim 1**, Dunn discloses a method of presenting interactive video entertainment (e.g., VOD program), comprising:

providing plural viewing channels (e.g., VOD channel, non-VOD channel, EPG channel...etc – see col. 3, lines 34-38);

on certain of the channels, providing television programs (for example, non-channels provide news, movie, or sport programs);

on at least one of the channels, providing interactive video entertainment (e.g., VOD channel provides VOD program) (col. 3, lines 34-42); and

when switching away from an interactive video entertainment channel (e.g., VOD channel), storing state information associated with the interactive video entertainment channel (storing a pause point associated with the VOD channel when the user switches away from the VOD channel – see col. 7, lines 52-54; col. 6, 16-33 and 41-50); and

when thereafter switching back to the interactive video entertainment channel restoring the state information (the pause point is used later to resume play when the viewer switches back to the VOD channel – see col. 6, lines 53-55).

Regarding **claim 2**, Dunn discloses that the pause point includes a pointer associated with a point at which the VOD program was interrupted when switching away from the VOD channel (see col. 6, lines 40-50).

Regarding **claim 3**, Dunn discloses that the pause point is used to resume transmission of the VOD program from the substantially the point of interruption (see col. 6, lines 53-55).

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Regarding **claim 5**, Dunn discloses that the VOD program is provided to a client terminal (28 – see figure 1) from a headend 22 (see figure 1), and the method includes creating a pointer to memory location within the CMS database at headend 22, remote from the client terminal 28 (see col. 6, lines 46-53; col. 2, lines 53-56 and figure 1).

Regarding **claim 6**, Dunn discloses switching between the channels using a remote control device (see col. 7, lines 22-29; col. 6, lines 16-19).

Regarding **claim 7**, Dunn discloses using a remote control device in conjunction with an on-screen electronic programming guide to browse the plural viewing channels (see col. 7, lines 22-24; col. 3, lines 21-23 and col. 4, lines 17-21); and selecting a channel, e.g., VOD channel, providing the VOD program (see col. 3, lines 39-42).

Regarding **claim 12**, Dunn discloses providing an on-screen user interface, e.g., screen display 80 of the preview UI of VOD application, with plural controls such as order 86, choices 88, add to list 90...etc for the user to interact with the VOD channel (see col. 5, lines 8-15 and figure 3).

Regarding **claim 13**, Dunn discloses receiving a downloaded software control package, e.g., VOD application, in response to selecting a specific interactive content, e.g., movies, video games, or TV shows, on the VOD channel; and providing an on-screen user interface, e.g., screen display of the preview browse UI of VOD application, with plural controls associated with the specific interactive content (see col. 3, lines 13-20; col. 4, line 60 to col. 5, line 24).

Regarding **claim 14**, Dunn discloses that the specific interactive content is a multiuser interactive content (VOD program such as movie, game, or TV shows – see col. 3, lines 15-19).

Regarding **claim 15**, Dunn discloses a computer-readable storage medium having stored thereon computer executable instructions for performing a method of presenting an on-demand video (see abstract and col. 12, lines 38-40):

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defining plural viewing channels (e.g., VOD channel, non-VOD channel, EPG channel...etc – see col. 3, lines 34-38);

on certain of the channels, providing television programs (for example, non-channels provide news, movie, or sport programs);

on at least one of the channels, displaying the on-demand video (e.g., VOD channel provides VOD program) (col. 3, lines 34-42); and

switching away from the channel (e.g., VOD channel) displaying the on-demand video to another of the plural viewing channels (e.g., non-VOD channel) and storing state information associated with a point of interruption of the on-demand video (storing a pause point associated with a point of interruption, e.g., pause, of the VOD program when the user switches away from the VOD channel to non-VOD channel – see col. 7, lines 52-54; col. 6, 16-33 and 41-50); and

when thereafter switching back to the channel displaying the on-demand video, restoring the state information to display the on-demand video from substantially the point of interruption (the pause point is used later to resume play when the viewer switches back to the VOD channel – see col. 6, lines 53-55).

Regarding **claim 16**, Dunn discloses a system for presenting video entertainment, the system comprising:

means for receiving a composite signal comprising television channels (e.g., a designated channel for VOD, a designated channel for EPG...etc) and at least one interactive video entertainment channel (e.g., VOD channel – see col. 2, lines 53-56; col. 3, lines 35-37);

means for switching between the channels (switching between VOD channel and non-VOD channel – see col. 6, lines 16-20);

means for displaying the channels (see col. 6, lines 16-20); and

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means for storing state information associated with the interactive video entertainment channel (storing a pause point associated with the VOD channel when the user switches away from the VOD channel – see col. 7, lines 52-54; col. 6, lines 41-50);

wherein, after switching back to the interactive video entertainment channel after switching away, the state information is used to resume an earlier-commenced activity on the interactive video entertainment channel from a point of interruption (switching back to the VOD channel after switching away, the video content playing unit addresses the CMS database at a resume point that is earlier in the video content program than the pause point referenced by the pointer – see col. 7, line 67 to col. 8, line 10).

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 17 and 18 are rejected under 35 U.S.C. 102(e) as being anticipated by Daniels (US 20020100044 A1).

Regarding **claim 17**, Daniels discloses a method of presenting interactive video entertainment comprising:

receiving a composite signal comprising plural viewing channels; on at least one of the channels, providing interactive video entertainment (receiving an incoming television and/or data signal, the television signal includes channels at prescribed frequencies. Some of these channels carry the television programs and some carry the data – see page 16, 0162);

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displaying a real time broadcast program (e.g., program 1), in response to a switching input received from a remote control (for instance, displaying program 1 in response to a selection from the user via a button on a remote control – see page 4, 0036; page 6, 0085);

recording the real time broadcast program in a memory device (e.g., magnetic recording tape, DRAM...etc) in response to receiving a delay input from the remote control (for instance, recording a first portion 1 of the program 1 in the memory device, e.g., magnetic recording tape, DRAM...etc, in response to receiving a pause mode from the remote control – see page 4, 0036; page 6, 0085; page 7, 0091); and

displaying the recorded real time broadcast program from the memory device while simultaneously continuing to record the real time broadcast program in the memory device, in response to receiving a resume input from the remote control (displaying the recorded first portion 1 of the program 1 from the memory device at the same time a second portion 1 of the program 1 in the memory device, in response to receiving a resume mode from the remote control - see page 4, 0036; page 0083 and 0085; page 7, 0091).

Regarding **claim 18**, Daniels discloses an electronic programming guide including a list of the real time broadcast programs (see page 17, 0165 and abstract).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 4 and 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dunn et al. (U.S. 5,721,829 A).

Regarding **claim 4**, Dunn discloses the that the VOD program is presented for display at a client terminal (28) (see figure 1 and col. 2, lines 51-53). Dun also discloses that the client terminal sends a pause message to the headend to determine a pause point at which the program is stopped (see col. 6, lines 26-60). Dunn does not explicitly disclose storing the pointer at the client terminal. Official Notice is taken that a pointer indicating a pause point of the program is stored at a viewer terminal is well known in the art. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system of Dunn by storing a pointer indicating a pause point of the program at the client terminal for later to resume the program locally.

Regarding **claim 9**, Dunn discloses switching from playing a program on VOD channel to a non-VOD channel (see col. 6, lines 16-19). Dunn does not explicitly discloses viewing email while switching away from the program on VOD channel. Official Notice is taken that it is well known in the art to provide email service for viewing on TV. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system of Dunn by including email service for viewing on TV to enhance the television services.

Regarding **claim 10**, Dunn discloses that the pause point includes a pointer associated with a point at which the VOD program was interrupted when switching away from the VOD channel, e.g., pause mode, and when switching back to the VOD channel e.g., resume mode, resuming the VOD program at the point of interruption. It is noted that pause/resume feature is automatic and requires no activity on the part of the viewer (see col. 7, lines 9-19; col. 6, lines 40-43 and 53-55; col. 8, lines 11-16).

Regarding **claim 11**, Dunn does not explicitly disclose screen is overscanned. Official Notice is taken that the overscan area for carrying non-display information in the video signal is well known in the art. Therefore, it would have been obvious to one having ordinary skill in the

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art at the time the invention was made to modify the system of Dunn by providing the overscan area for carrying non-display information in the video signal.

10. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dunn et al. (U.S. 5,721,829 A) in view of Wolf et al. (US 5,461,415 A).

Regarding **claim 8**, Dunn discloses that before switching away from the VOD channel, the VOD program is transmitted over a channel (see col. 5, lines 58-41), when switching back to the VOD channel, the transmission of the program is resumed (see col. 7, lines 9-19). Dunn does not explicitly disclose resuming the program over a different transmission channel. However, Wolf discloses that when the video server receives a pause request and then a subsequent resume request from user, it transmits the video via the look ahead stream instead of the common data stream (see col. 1, lines 55-59). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system of Dunn by transmitting the resume requested video via the look ahead stream instead of common data stream in order to cut waiting time for user getting back the video stream of the program.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Dan et al. (US 5,453,779 A) discloses a integrated scheduling approach that provides VCR control functions to clients without always requiring a separate video stream fro all clients.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ngoc K. Vu whose telephone number is 703-306-5976. The examiner can normally be reached on Monday-Thursday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Grant can be reached on 703-305-4755. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Ngoc K. Vu
Examiner
Art Unit 2611

November 15, 2004